

### Remarks

Favorable reconsideration of this application is requested in view of the following remarks. For the reasons set forth below, Applicant respectfully submits that the claimed invention is allowable over the cited references.

The non-final Office Action dated August 10, 2004, indicated that the drawings are objected to as failing to comply with 37 CFR 1.84(p)(5). Claims 1-4, 6, 8, 9, 11-18, 20-22, 24, and 27-33 stand objected to because of the following informalities: In the claims the phraseology “adapted to” is not a positive limitation since it only requires the ability to perform a function. Claim 18 stands further objected to because of the following informalities: There is a minor grammatical error in the wording of claim 18. Claims 1, 33, and 34 stand rejected under 35 U.S.C. § 112, first paragraph. Claims 1-14, 20-28, 32-39, 44, 45, 48-50 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Colby et al.*, U.S. Patent 6,006,264. Claims 15, 16, 29, 40-43 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Colby* in view of *Miller et al.*, U.S. patent 5,920,701. Claims 17, 46, 47 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Colby* in view of *Wolpert*, U.S. patent 6,577,601. Claims 18, 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Colby* in view of *Wolpert*, and further in view of *Miller*. Claims 30, 31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Colby* in view of *Reed et al.*, U.S. patent 5,862,325.

The amendment to the specification, correcting informalities in replacing reference to characters “166” and “168” with reference to characters “163” and “165,” should overcome the objections to the drawings. Applicant appreciates the Examiner’s attention to these details.

Applicant respectfully traverses the objection to the claims. The terminology “adapted to” is accepted terminology in PTO practice in defining an element of the claimed invention in functional terms. *See* M.P.E.P. §2173.05(g). The use of “adapted to” is supported by case law as being proper terminology for defining attributes that a structural element possesses. *In re Venezia*, 530 F2d. 956, 189 USPQ 149 (CCPA) 1976 (“members adapted to be positioned”... serve to precisely define present structural attributes of interrelated component parts of the claimed assembly.”) This may be distinguished from the discussion of the term “adapted” in *In re Hutchison* where “adapted” is used in the introductory clause, or preamble, of the claim, contrary to the present application where “adapted” is used within the claim to define interrelated component parts of the claimed invention. According to long-standing patent law, language used

in the preamble does not constitute a limitation unless the language breathes life and meaning into the claim. *See, DeGeorge v. Bernier*, 768 F.2d 1318, 226 USPQ 758 (Fed. Cir. 1985) (Generally, the preamble does not limit a claim unless preamble limitations are necessary to give meaning to the claim and properly define the invention.) Thus, it would appear that *In re Hutchison* is distinguished because the claim at issue in that case did not include “adapted” in the body of the claim.

In addition, the terminology rejected by the Examiner has become well accepted in PTO practice in connection with functional claiming in “means for” claims under 35 U.S.C. §112(6). *See* M.P.E.P. §218; *DeGraffenreid v. United States*, 20 Ct. Cl. 458, 16 USPQ2d 1321 (Ct. Cl. 1990) (“force generating means adapted to provide...”). Further, a sampling of the U.S. Patent Office’s own database through December 8, 2004 indicates that the term “adapted” has been used in the claims of over 431,500 issued patents. Moreover, it is well recognized in Patent Office practice that it is not inherently wrong to define some part of an invention in functional terms. *See* M.P.E.P. §2173.05(g) (“Functional language does not, in and of itself, render a claim improper.” *See, In re Swinehart*, 439 F.2d. 210, 169 USPQ 226 (CCPA 1971)). In view of the foregoing, the “adapted to” terminology is proper claim terminology and the objection should be withdrawn.

The objection to the informality in claim 18 should be overcome with the amendment made thereto, removing the inadvertent term “the” as suggested by the Examiner. This amendment was made to address this informality and accordingly not made for reasons of patentability. Applicant appreciates the Examiner’s attention to this claim detail.

Applicant respectfully traverses the Section 112(1) rejections because the claims and the instant specification, as construed by one skilled in the art, meet all of the requirements of §112(1). Applicable case law states that “[t]he written description requirement does not require the applicant “to describe exactly the subject matter claimed, [instead] the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed.” Union Oil Co. of California v. Atlantic Richfield Co., 208 F.3d 989 (Fed. Cir. 2000), *cert. denied*, 69 U.S.L.W. 3165 (Feb. 20, 2001) (No. 00-249) (quoting *In re Gosteli*, 872 F.2d 1008, 1012, 10 U.S.P.Q.2d 1614, 1618 (Fed. Cir. 1989) (citations omitted)).

In this instance, several examples in the specification and/or in the figures show and describe the implementation of an application routing controller at various levels and/or using

various coordinated layers of a network for routing data. For example, referring to FIG. 3 and the corresponding discussion in the paragraph beginning on line 13 of page 12, an application routing controller 305 is implemented at various levels throughout the network, including levels at nodes 320 and 321, used to route data to node 324. In some implementations, the application routing controller is implemented at different levels to include the establishment of an application routing buffer at node 320 as described in the specification at page 13, line 23 through page 14, line 8. Referring to FIG. 5 and the corresponding discussion beginning at line 20 of page 15, one or more application router nodes (530 and 590, by way of example) are implemented with a software-based network router application (application router) at various portions of the network system 500.

In specific regard to the claimed terminology directed to “various coordinated layers” of a network, the above examples as well as others such as those shown in FIGs. 1-3 and 6 clearly show routing over layers in a network, with a multitude of communications links, system/user nodes and networks shown and described in connection therewith. Using FIG. 3 as an example, routing to node 324, between nodes 324 and 322 and other configurations are shown and described using various coordinated layers to route data (*e.g.*, using links 336, 334 and 332 to route data from node 324 to node 322).

In view of the above examples and those in other portions of the specification (including the claims), Applicant submits that the claims and specification meet the written description requirement of Section 112(1). Therefore, Applicant requests that the Section 112(1) rejection be removed.

Applicant respectfully traverses all of the Section 102 and section 103 rejections, each of which relies upon the ‘264 reference, because the Office Action failed to cite teachings in the ‘264 reference that correspond to the claimed limitations. For example, lines 48-58 of column 2 in the ‘264 reference are improperly asserted as teaching a network-distributed application routing controller, made in reference to independent claims 1, 33 and 34. Contrary to the assertion in the Office Action, this cited portion of the ‘264 reference refers to a flow switch (*e.g.*, content-aware flow switch 110 of FIG. 1c) that simply forwards a request for information to an appropriate server (*e.g.*, web server 100a, 100b or 100c) and acts as a “full duplex logical connection” (*see* column 5, line 65).

While the Office Action has not shown explicitly how data is routed in the ‘264 reference, it appears that one of the web servers responds to a request by sending data relative to the request through the flow switch and to a client (*see, e.g.*, column 5, line 62 through column 6, line 6). In this regard, the Office Action has not shown any information in the ‘264 reference that would indicate that the flow switch is a router in the context of the present invention or, more particularly, that the flow switch is network-distributed and directs routing of supplied data from a supply node to a requesting node. Further, the Office Action has not shown how the flow switch in the ‘264 reference ascertains a location of supplied data and, further, directs the routing of the supplied data from a source to a requesting destination. Referring to the cited portion of column 2 of the ‘264 reference, it appears that the flow switch in the ‘264 reference does not serve a content request; rather, the flow switch directs such a request to a server that can serve the request. Referring again to FIG. 1c of the ‘264 reference, once the flow switch passes along a request to a particular server, it is out of the loop for controlling the supplied data and simply waits for a response. Therefore, the flow switch does not “direct routing” of supplied data from a network node as claimed in the instant invention.

In view of the above, all of the claim rejections, including the Section 102 and 103 rejections, and those of the dependent claims, are improper because the asserted portions of the ‘264 reference do not teach or suggest the limitations indicated in the Office Action. In this regard, further discussion of the other claim rejections should not be necessary. However, selected ones of the remaining rejections are addressed as follows.

Referring to the rejection of claim 4 on page 6 of the Office Action, the cited portion of the ‘264 reference does not describe routing between two system nodes coupled to a server via a network, as asserted. Instead, the cited portion (column 5, lines 43-51) of the ‘264 reference is directed to routing from a server to a client-side node, which is apparently being asserted as a system node, as shown in FIG. 1c. The cited portion of the ‘264 reference does not teach or suggest limitations directed towards routing data between two system or user nodes (*e.g.*, between two nodes on the client-side of FIG. 1c). Therefore, the assertion in the Office Action is incorrect and the rejections relying thereupon should be removed.

Regarding the rejection of claims 6 – 8 on pages 6 – 7 of the Office Action, the Examiner appears to be making an inherency type argument without providing any support in the cited reference (or from the prior art) supporting the allegedly inherent teachings. To establish

inherency, the extrinsic evidence “must make clear that the missing descriptive matter *is necessarily present in the thing described in the reference*, and that it would be so recognized by persons of ordinary skill.” *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991) (emphasis added). “Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *Id.* at 1269, 20 U.S.P.Q.2d at 1749 (quoting *In re Oelrich*, 666 F.2d 578, 581, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981)). In this instance, no such extrinsic evidence has been provided. Further, it is unclear as to why replication would be inherent with the subject matter in the ‘264 reference, as the cited portion of the ‘264 reference is directed to using a different server source, rather than replicating data. Therefore, the rejections based upon this inherent allegation are improper and, further, the ‘264 reference appears to teach away from the alleged inherent teachings. Additional allegations of inherency made in connection with the rejection of claims including claims 12 and 22 are improper for similar reasons.

Regarding the rejection of claims 13 and 14, the cited portion of the ‘264 reference does not, as Office Action asserts, teach limitations directed to the routing of data relative to an identified communication link having sufficient availability. Rather, the cited portions (column 16, line 66 through column 17, line 15) of the ‘264 reference appear directed to leveling, or equaling, flow from particular “virtual web hosts” rather than using a particular link based upon its availability. In this regard, the claim rejections relying upon this assertion are improper.

The Section 103 rejections are also improper because each of the rejections fail to establish a *prima facie* case of obviousness. As discussed above, each of the Section 103 rejections relies upon the ‘264 reference as a primary reference. In view of the above-discussed improprieties relating to the Section 102 rejections, the ‘264 reference correspondingly fails to teach or suggest the various claimed limitations as asserted in the Office Action. Furthermore, the Office Action failed to provide evidence of motivation from the prior art, specifically suggesting modification of the primary ‘264 reference (*i.e.*, stating an advantage of a proposed modification does not show why one of skill in the art would have, at the time of the invention, been motivated to accordingly modify the primary reference). Relevant case law indicates that, without such evidence, there is no motivation to modify the primary reference.

Notwithstanding the above, amendments to the claims may otherwise overcome the objections and/or rejections in the Office Action.

The independent claims have been amended to broaden certain aspects thereof and further to describe terminology more consistently with the specification. Various amendments to the dependent claims have been made for consistency in terminology. Certain claim amendments have also been made to address informalities therein; these amendments do not change the scope of the claims. None of the claim amendments are made to overcome any prior art rejection; as described above, all of the claim rejections are improper.

New claim 51 has been added and includes subject matter removed from claim 1 by amendment herein.

In view of the above discussion, Applicant believes that the rejection has been overcome and the application is in condition for allowance. A favorable response is requested. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is encouraged to contact the undersigned at (651) 686-6633.

Respectfully submitted,

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Encl.

Replacement drawing sheet

**In the Drawings:**

Please replace FIG. 2 with the figured in the attached replacement drawing sheet. The drawing has been amended to be commensurate with the specification, with the labeling of the routing controller 150 changed from “Data Routing Controller” to “Application Routing Controller.”